UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT MARK,
KATHLEEN H. YOUNG, and
ANDREW WOOD

Appeal No. 2005-2586
Application No. 09/425,501

ON BRIEF

Before ELLIS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 43, 44 and 49-65. Claims 51 and 52 are representative of the subject matter on appeal, and read as follows:

51. An isolated nucleic acid molecule comprising a nucleotide sequence encoding an isolated human Bcl-xL binding protein as shown in SEQ ID NO:1.

52. A nucleic acid molecule comprising a nucleic acid sequence encoding an isolated human Bcl-xL domain, wherein said domain is a fragment of the nucleic acid molecules as shown in SEQ ID NO:1.

The examiner relies upon the following reference:

Nagase et al. (Nagase), "Prediction of the Coding Sequences of Unidentified Human Genes. VI. The Coding Sequences of 80 New Genes (KIAA0201-KIAA0280) Deduced by Analysis of cDNA Clones from Cell Line KG-1 and Brain," DNA Res., Vol. 3, pp. 321-329 (1996)

Claims 43, 44 and 49-65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nagase. In addition, claims 49-53 and 57-59 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, i.e., lack of adequate written description. After careful review of the record and consideration of the issues before us, we affirm the rejection of claims 43, 44 and 49-65 under 35 U.S.C. § 102(b) as being anticipated by Nagase. Because we have affirmed that rejection, we decline to reach the merits of the rejection under 35 U.S.C. § 112, first paragraph, for lack of adequate written description.

DISCUSSION

Claims 43, 44 and 49-65[1] stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nagase.

Appellants group the claims for purposes of this rejection into two groups, with Group I comprising claims to the full-length sequence, see Appeal Brief, page 2, i.e., claims 43, 44, 49-51, 54-61 and 65,[2] and Group II comprising claims 52, 53, 62, 63 and 64, see id. at 5. We find claim 51 to be representative of Group I, and claim 52 to be representative of Group II, and we thus focus our analysis on those claims.

According to the rejection,

> Nagase [ ] teaches the coding sequence[s, sic] of cDNA clone[s, sic] from human myeloid cell line KG-1 and brain wherein Nagase [ ] disclose[s] a cDNA clone which is identical or absolute homology (100%) to the claimed sequences of SEQ ID Nos. 1 and 2 of the instant invention (see sequence alignment from GenEmbl. and Swissprot_39 databases). Nagase [ ] also disclose[s] that the cDNA clones showed homology to the genes that play key roles in regulation of developmental stages, apoptosis and cell-to-cell interaction (see page 321, abstract). Thus the disclosure of Nagase [ ] meets the limitations in the instant claims.

Examiner's Answer, page 3.

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[1] The Examiner's Answer states that claims 43-65 are rejected, but as claims 45-48 have been cancelled, see Paper dated March 12, 2002, we assume that the reference to claims 43-65 was a typographical error and that the examiner in fact meant claims 43, 44 and 49-65.

[2] The Appeal Brief refers to the full length sequence, and specifically refers to claims 43, 44, 49, 51, 54-57, 59-61 and 65. See Appeal Brief, page 2. In referring to the fragments, however, the Appeal Brief refers to claims 52, 53, 62, 63 and 64. See id. at 5. The rejection, however, is over all of the pending claims, i.e., claims 43, 44 and 49-65, and thus claims 50 and 58 have been left out. As these claims are drawn to the full length sequence, we have included them in Group I, and thus Group I is drawn to claims 43, 44, 49-51, 54-61 and 65.

Appellants argue that "Nagase does not anticipate the instant invention because Nagase does provide an enabling disclosure because Nagase discloses no use whatsoever for the bare sequences disclosed." Appeal Brief, page 2 (emphasis in original). Appellants cite In re Hoeksema, 399 F.2d 269, 273 (CCPA 1968), for the proposition that in order "[t]o anticipate an invention a reference must provide an enabling disclosure," and assert that as Nagase only provides the primary structure of the DNA, and discloses no use for the DNA, the situation is analogous to that in Hoeksema, and thus Nagase cannot anticipate the rejected claims. Id. at 3.

Appellants' arguments are not found to be convincing. We first note that appellants do not argue that Nagase does not teach the nucleotide sequence of SEQ ID NO: 1 as required by claim 51, thus we take it as admitted that Nagase does teach such a sequence. Second, we have considered appellants' arguments that Nagase does not anticipate the nucleotide sequence of claim 51 because it does not provide an enabling disclosure as it relies upon In re Hoeksema, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968) and In re LeGrice, 301 F.2d, 929, 936, 133 USPQ 365 (CCPA 1962),[3] but do not find that those cases support appellants' position. LeGrice dealt with a plant patent to a rose, and the court held that the mere description of a plant is not an enabling disclosure, unless that description in conjunction with the knowledge of those

[3] We also note appellants citation to Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 55 (1870), but do not find it to be relevant to the issue before us as that case was decided well before the codification of 35 U.S.C. § 102.

skilled in the art places the plant in the possession of those so skilled. See id., 301 F.2d at 939, 133 USPQ at 373-74. That is, the description must enable one skilled in the art to "make" the plant. Similarly, in Hoeksema, the court held "that if the prior art of record fails to disclose or render obvious a method of making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in possession of the public." See id., 399 F.2d at 274, 158 USPQ at 601. Thus, both LeGrice and Hoeksema held that in order to serve as an anticipatory reference, the reference must place the claimed product in possession of the public, i.e., enable one to make the claimed product.

As succinctly stated by the Court of Appeals for the Federal Circuit, our reviewing court,

> In order to anticipate, a prior art disclosure must also be enabling, such that one of ordinary skill in the art could practice the invention without undue experimentation. SmithKline Beecham, 403 F.3d at 1342. The standard for enablement of a prior art reference for purposes of anticipation under section 102 differs from the enablement standard under 35 U.S.C. § 112. Rasmusson v. SmithKline Beecham Corp., 413 F.3d 1318, 1325 (Fed. Cir. 2005) (citation omitted). While section 112 "provides that the specification must enable one skilled in the art to 'use' the invention," id. (quoting In re Hafner, 56 C.C.P.A. 1424, 410 F.2d 1403, 1405 (1969)), "section 102 makes no such requirement as to an anticipatory disclosure," id.

Novo Nordisk Pharmaceuticals, Inc. v. Bio-Technology General Corp., 424 F.3d 1347, 1355, 76 USPQ2d 1811, 1816-17 (Fed. Cir. 2005).

The Court of Appeal for the Federal Circuit has thus made clear that all that is required by an anticipatory reference is that it enable one skilled in the art to make the claimed invention, but that there is no requirement that the reference teach the skilled artisan how to use the claimed invention. In the case before us, appellants do not refute "the ability of one skilled in the art to synthesize [i.e., make] the sequence given the teaching in Nagase," Appeal Brief, page 4, thus Nagase place SEQ ID No. 1 as required by claim 51 in possession of the public, and thus anticipates the invention of claim 51. As claims 43, 44, 49, 50, 54-61 and 65 stand or fall with claim 51, the rejection of claims 43, 44, 49-51, 54-61 and 65 under 35 U.S.C. § 102(b) as anticipated by Nagase is affirmed.

Appellants argue with respect to Group II, i.e., claims 52, 53, 62, 63 and 64, that "[e]ven if Nagase is found to anticipate the full length sequence . . . the fragments disclosed are patentable over the full length sequence," and that "Nagase makes no suggestion of any binding sites or the sequence's function as a modulator of apoptosis." Appeal Brief, page 5.

Claim 52, the representative claim for Group II, recites "[a] nucleic acid molecule comprising a nucleic acid sequence encoding an isolated human Bcl-xL domain, wherein said domain is a fragment of the nucleic acid molecules as shown in SEQ ID NO:1" (emphasis added). The use of the open-ended transitional phrase "comprising" does not exclude additional nucleotides, and thus claim 52 reads on the full length sequence, i.e., reads of SEQ ID NO: 1.

See In re Crish, 393 F.3d 1253, 1257, 73 USPQ2d 1364, 1367 (Fed. Cir. 2004). Thus, the rejection of the Group II claims, i.e., claims 52, 53, 62, 63 and 64 is affirmed for the reasons set forth above with respect to the claims of Group I.

CONCLUSION

We affirm the rejection of claims 43, 44 and 49-65 under 35 U.S.C. § 102(b) as being anticipated by Nagase. Because we have affirmed that rejection, we decline to reach the merits of the rejection of claims 49-53 and 57-59 under 35 U.S.C. § 112, first paragraph, for lack of adequate written description.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Joan Ellis
Administrative Patent Judge)

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Lora M. Green
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